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09/681,573	05/01/2001	Ignatius M. Zettel	GEMS8081.072	6753
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ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (GEMS)			STORK, KYLE R	
14135 NORTH CEDARBURG ROAD			ART UNIT	
MEQUON, WI 53097			PAPER NUMBER	

2178

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/681,573

**Applicant(s)**

ZETTEL ET AL.

**Examiner**

Kyle R Stork

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This non-final office action is in response to the request for continuing examination and the amendment filed 30 March 2005.
2. Claims 1-29 are pending. Claims 1, 8, 16, and 25 are independent claims. The rejection of claims 16-24 under 35 U.S.C. 112 has been withdrawn as necessitated by the amendment. The rejection of claims 8-15 under 35 U.S.C. 101 has been withdrawn as necessitated by the amendment. The rejection of claims 1-2, 4-11, 13-15, 25, and 27 under 35 U.S.C. 102 under Academic Technology Services (hereafter ATS) (Adobe PDF for Electronic Publishing, 1999) have been withdrawn as necessitated by the amendment. The rejection of claims 3, 12, 16-24, and 26-29 under 35 U.S.C. 103 under the combinations of ATS and Williams (US 5251314, 1993), Alam et al. (US 6336124, hereafter Alam), Ouchi (U.S. 6,370,567), and Chen et al. (U.S. 6,009,442, hereafter Chen), as necessitated by the amendment.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether the applicant intends for the program to route the document to at least one:

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- Supervising approver
- Workflow recipient;

or if the applicant intends for the document to be routed to:

- At least one supervising approver; and
- Workflow recipient

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-11, 13-15, 25, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Academic Technology Services (hereafter ATS) (Adobe PDF for Electronic Publishing, 1999) and further in view of Bendik (US 2002/0002563, filed 23 August 1999, published 3 January 2002).

As per independent claim 1, ATS discloses a method to electronically publish media comprising the steps of:

- Accessing an electronic data file (page 3, number 1)
- Receiving a publication instruction from a user to publishing the accessed data file (page 3, number 2)

- Initializing a publication enabler capable of converting a data file into at least one publication format, wherein the publication enabler is independent of a document creation application used to create the electronic file (pages 4-5, numbers 3-6)
- If necessary, converting the accessed data file directly into another publication format (pages 4-5, numbers 3-6)
- Publishing the data file in at least one publication format (page 5, number 7)

ATS fails to specifically disclose a document management system. However, Bendik discloses a document management system with storage criteria (paragraphs 0007-0013).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS's method with Bendik's method, since it would have allowed a user to easily share documents within a workgroup without requiring knowledge of the DOS filename or the physical location of the document (Bendik: paragraph 0002).

As per dependent claim 2, ATS and Bendik discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. ATS further discloses the method wherein the step of publishing further comprises storing the data file in memory of a computer (page 5, number 7: Here, the PDF can be immediately displayed and stored).

As per dependent claim 3, ATS and Bendik disclose the limitations similar to those in claim 2, and the same rejection is incorporated herein. Bendik further discloses the method further comprising the step of routing a publication notification to at least

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one of an approving supervisor and a work flow recipient from the publication enabler (paragraphs 0058-0059).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS and Bendik's method with Bendik's method, since it would have allowed for easy collaboration between workgroups.

As per dependent claim 4, ATS and Bendik discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. ATS further discloses the method wherein at least one of the publication format includes at least one of an RTF, HTML, PDF, TIFF, JPEG, GIF, BMP, and fax compression format (page 5, number 7).

As per dependent claim 5 ATS and Bendik discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. ATS further discloses the method wherein the step of publishing further comprises the step of transmitting the data file to a system wherein the data file are configured to allow the system to automatically assign a coded filename, a storage location, and a file identifier to the data file (page 5, number 7: Here, the file is saved to the hard drive in a document management system under a filename). Bendik further discloses the method wherein a document management system receives a plurality of parameters used to automatically assign a file a coded filename, a storage location, and a file identifier (paragraph 0049: Here, a naming system is created when the document management system is implemented. This naming system specifies the coded file name, storage location, and file identifier that all documents will receive, based upon the document's parameters).

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It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS's method with Bendik's method, since it would have allowed a user to easily share documents within a workgroup without requiring knowledge of the DOS filename or the physical location of the document (Bendik: paragraph 0002).

As per dependent claim 6 ATS and Bendik discloses the limitations similar to those in claim 5, and the same rejection is incorporated herein. ATS discloses the method further comprising the step of retrieving the data file based on any of the file identifier, coded filename, storage location, and document parameters wherein the document parameters include at least one of an author, a title, a subject, a format, an approver, and a work flow recipient (page 13, Viewing a PDF file: Here, the data file is retrieved through the filename based upon a user selection).

As per dependent claim 7 ATS and Bendik disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. ATS further discloses the method wherein the publication instruction is a print command and further comprising the steps of initializing the publication enabler with an application capable of printing the electronic data file (page 3, Creating a PDF from an existing electronic document: Here, the PDF is published from a word processing document, through a print command).

As per independent claim 8, the applicant discloses the computer readable storage device having stored thereon a program for executing the method of claim 1. Claim 8 is similarly rejected under ATS and Bendik.

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As per dependent claim 9 ATS and Bendik disclose the limitations similar to those in claim 8, and the same rejection is incorporated herein. ATS further discloses the computer readable storage device wherein the at least one publication format includes media formats foreign to the media creation application (page 3, Creating a PDF from an existing electronic document: Here, the original document is foreign to the final PDF application).

As per dependent claim 10 ATS and Bendik disclose the limitations similar to those in claim 8, and the same rejection is incorporated herein. ATS further discloses the computer readable storage device wherein the at least one publication format includes at least one of a portable document format, a hypertext markup language, an x-markup language, a rich text format, a JPEG format, a GIF format, a TIFF format, encryption formats, a bitmap format, compression format, or electronic messaging formats (page 5, number 7).

As per dependent claim 11, the applicant discloses the computer readable storage device for executing the method of claim 5. Claim 11 is similarly rejected under ATS and Bendik.

As per dependent claim 13 ATS and Bendik disclose the limitations similar to those in claim 8, and the same rejection is incorporated herein. ATS further discloses the computer readable storage device wherein the computer is further caused to initialize the media publisher in response to a print command from a plurality of media creation applications (page 3, Important Note: Here, the publishing can be implemented



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with files stored on either a Window or Macintosh machine, each machine containing different proprietary applications).

As per dependent claim 14, the applicant discloses the computer readable storage device for executing the method of claim 6. Claim 14 is similarly rejected under ATS and Bendik.

As per dependent claim 15 ATS and Bendik disclose the limitations similar to those in claim 8, and the same rejection is incorporated herein. ATS and Bendik further discloses the computer readable storage device wherein the computer is further caused to electronically transmit the content to a remote terminal to at least one of a supervising approver and a workflow recipient (ATS: page 14: Distributing and Viewing PDF files on the Web: Here, the web is a communication interface; Bendik: paragraph 0058-0059: Here, the document or a link to the document is mailed to another person for review and modification).

As per independent claim 25, ATS discloses a system for publishing document to a document management system comprising:

- A computerized network (page 14: Distributing and Viewing PDF files on the Web: Here, the web is a computerized network)
- A readable memory electronically linked to a network (page 14: Distributing and Viewing PDF files on the Web: Here, the server is a memory electronically linked to a network)

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- A plurality of computer connected to the network, wherein at least one of the plurality of computers, displays electronic data to a user in the form of a GUI (page 14: Distributing and Viewing PDF files on the Web; page 3)
- A processing unit programmed to call the GUI on demand and enable a user selection of one or more publication formats, wherein the one or more publication formats including publications formats non-native to a creation document (pages 4-5, numbers 3-6)
- The processing unit is further programmed to convert a document to at least one of the publication formats and call the GUI directly from the application used to create a document a user desires to publish (page 5, number 7)

ATS fails to specifically disclose conforming to a document management system with parameters. However, Bendik discloses conforming data to a document management system with parameters (paragraph 0049).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS's method with Bendik's method, since it would have allowed a user to easily share documents within a workgroup without requiring knowledge of the DOS filename or the physical location of the document (Bendik: paragraph 0002).

As per dependent claim 27 ATS and Bendik disclose the limitations similar to those in claim 25, and the same rejection is incorporated herein. Bendik further discloses the system wherein the processing unit is further programmed to automatically assign document management system publication parameters, wherein

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the document management system parameters include at least one of a document category, document format, document approval, and document workflow (paragraph 0049).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS's method with Bendik's method, since it would have allowed a user to easily share documents within a workgroup without requiring knowledge of the DOS filename or the physical location of the document (Bendik: paragraph 0002).

As per dependent claim 29, ATS and Bendik disclose the limitations similar to those in claim 25, and the same rejection is incorporated herein. Bendik further discloses the system wherein the processing unit is further programmed to route the document to at least one supervising approver and work flow document recipient upon a user instruction (paragraphs 0058-0059).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS and Bendik's method with Bendik's method, since it would have allowed for easy collaboration between workgroups.

7. Claims 12 and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over ATS and Bendik (US 2002/0002563, filed 23 August 1999, published 3 January 2002) and further in view of Alam et al. (US 6336124, filed 7 July 1999, patent 1 January 2002, hereafter Alam).

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As per dependent claim 12, ATS and Bendik disclose the limitations similar to those in claim 8, and the same rejection is incorporated herein. ATS and Bendik fail to specifically disclose the computer readable storage device wherein the computer further caused the computer to receive more than one media control instruction and simultaneously transform the content of the electronic media into more than one format. Alam discloses the computer program wherein the set of instructions further causes the computer to receive more than one media control instruction and simultaneously transform the content of the electronic media into more than one format (Figure 6, items 626 and 534: Here, a PDF and an Output Format Document are both generated based upon one command).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS and Bendik's program for publication with Alam's program for generating multiple document formats, since it would have allowed a user to generate multiple documents for several applications.

As per independent claim 16, ATS discloses the computer readable storage medium having a computer program stored thereon and embodying a sequence of instructions that when executed by a processor causes the processor to:

- (A) access an electronic file (page 3, number 1)
- (B) display a GUI configured to facilitate a user selection of a number of publications commands (pages 4-5, numbers 1-6)
- (C) receive a user selection of at least one publication command (page 3, number 2)

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- (E) transmit the converted data to at least one publication system capable of publishing the data file into a publication format (page 5, number 7)

ATS fails to specifically disclose:

- A document management system
- (D) route the electronic data file to a converter configured to substantially simultaneously convert the electronic data file into at least two of a number of publication formats
- (E) two converted data files

Bendik discloses a document management system (paragraphs 0007-0013).

Alam discloses:

- (D) route the electronic data file to a converter configured to substantially simultaneously convert the electronic data file into at least two of a number of publication formats (Figure 6: Here, a PDF and an Output Format Document are publication formats.)
- (E) two converted data files (Figure 6)

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS's medium with Bendik's medium, since it would have allowed a user to easily share documents within a workgroup without requiring knowledge of the DOS filename or the physical location of the document (Bendik: paragraph 0002). Further, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS and Bendik's

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medium with Alam's medium for using multiple data files, since it would have allowed a user to save time by creating more than one file with a single publication command.

As per dependent claim 17 ATS, Bendik, and Alam disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. ATS further discloses the medium wherein the sequence of instructions further causes the processor to display the GUI in response to a document management instruction (page 3, Figure 1).

As per dependent claim 18 ATS, Bendik, and Alam disclose the limitations similar to those in claim 17, and the same rejection is incorporated herein. ATS further discloses the medium wherein the sequence of instructions further causes the processor to execute acts (A) through (E) in response to a user print instruction (Figure 1).

As per dependent claim 19 ATS, Bendik, and Alam disclose the limitations similar to those in claim 18, and the same rejection is incorporated herein. ATS further discloses the medium wherein the sequence of instructions further causes the processor to recognize a user print instruction from any software application capable of printing the electronic data file (page 3, Creating a PDF from an existing electronic document).

As per dependent claim 20 ATS, Bendik, and Alam disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. Alam further discloses the print driver wherein the number of publication commands include a publish

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command including a convert to a PDF command and a convert to HTML command (column 2, lines 28-36).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS, Bendik, and Alam's medium for publication with Alam's method of converting to PDF and HTML, since it would have allowed a user to convert data into more than out format.

As per dependent claim 21, ATS, Bendik, and Alam disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. ATS further discloses the medium wherein the number of publication formats include PDF, JPEG, GIF, TIFF, HTML, XML, RTF, TXT, DOC, encryption, PPT, and ZIP (page 5, number 7).

As per dependent claim 22, ATS, Bendik, and Alam disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. ATS further discloses the medium wherein the sequence of instructions further causes the processor to retrieve an electronic data file from a document management system capable of storing the electronic data file (page 3, number 1: Here, opening the document in the original format is retrieving a stored document).

As per dependent claim 23 ATS, Bendik, and Alam disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. Alam discloses routing the converted data file to a supervisor and a subsequent document designate (column 2, lines 37-40).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined ATS and Alam's medium for publication with

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Alam's method for transmitting the document, since it would have allowed a user to submit data to another.

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over ATS, Bendik, and Alam and further in view of Ouchi (U.S. 6,370,567, filed 3 October 1999, patent 9 April 2002).

As per dependent claim 24 ATS, Bendik, and Alam disclose limitations similar to those in claim 16, and the same rejection is incorporated herein. ATS, Bendik, and Alam fail to specifically disclose displaying a listing of document approving supervisors. However, Ouchi discloses displaying a list of addresses in response to a user instruction (Figure 12; column 10, lines 63-66: The setting of the BRANCH INDICATOR is a user instruction). Although Ouchi is silent on the distribution list specifically being a listing of approving supervisors, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have listed supervisors on a distribution list.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined the medium of ATS, Bendik, and Alam with Ouchi's listing of supervisors in order to allow users to quickly notify selected supervisors of the publication of a document through a single message.



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9. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over ATS and Bendik and further in view of Chen et al. (U.S. 6,009,442, hereafter Chen, filed 8 November 1997, patent 28 December 1999).

As per dependent claim 26 ATS and Bendik disclose the limitations similar to those in claim 25 and the same rejection is incorporated herein. ATS fails to disclose a system wherein the processing unit is further programmed to automatically generate a document identifier and assign the document identifier to the document. However, Chen discloses a system wherein the processing unit is further programmed to automatically generate a document identifier and assign the document identifier to the document (column 4, lines 9-11; column 4, lines 22-27).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined the ATS and Bendik's system with Chen's system of assigning a document identifier to a document upon document generation, since it would have allowed a user to save a document with a default set of document attributes that are set upon document creation.

10. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over ATS and Bendik in view of Ouchi.

As per dependent claim 28 ATS and Bendik disclose limitations similar to those in claim 25, and the same rejection is incorporated herein. ATS fails to specifically disclose displaying a listing of document approving supervisors. However, Ouchi discloses displaying a list of addresses in response to a user instruction (Figure 12;

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column 10, lines 63-66: The setting of the BRANCH INDICATOR is a user instruction). Although Ouchi is silent on the distribution list specifically being a listing of approving supervisors, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have listed supervisors on a distribution list.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined the system of ATS with Ouchi's listing of supervisors in order to allow users to quickly notify selected supervisors of the publication of a document through a single message.

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

As detailed above, the Bendik reference has been added to address the amendments.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Johnson et al. (US 5843009, patent 22 September 1998): Discloses a document management system.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (703) 308-5465. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kyle Stork  
Patent Examiner  
Art Unit 2178

**hrs**

  
**CESAR PAULA**  
**PRIMARY EXAMINER**